

Application No.: 10/676454

Case No.: 58611US002

REMARKS

Claims 1 to 35 are pending. Claims 36 to 44 have been withdrawn from consideration. Claims 1, 10, 18, and 27 are amended.

Claims 1 to 17 stand rejected under 35 USC § 103(a) as being unpatentable over Komeda (JP 2001-234148). Claims 10-35 stand rejected under 35 USC § 103(a) as being unpatentable over Komeda in view of Wood et al. (US Pat. 5,940,921).

The burden is on the Examiner to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness the prior art reference must teach or suggest all the claim limitations. MPEP 2143.

Each independent claim has been amended such that the adhesive consists essentially of an elastomer and at least 56% by weight tackifier.

- Claim 1: a pressure sensitive adhesive layer consisting essentially of an elastomer and at least 56% by weight tackifier
- Claim 10: an adhesive coating consisting essentially of an elastomer and at least about 56% by weight tackifier
- Claim 18 an adhesive coating consisting essentially of an elastomer and at least about 56% by weight tackifier
- Claim 27 an adhesive coating consisting essentially of an elastomer and at least about 56% by weight tackifier

There is support in the specification for these amendments. At page 4, the second paragraph, detail is given as to types of adhesives useful for the adhesive layer. An elastomer is disclosed. The term elastomer is intended to be inclusive of a variety of specific types of adhesives.

The transitional phrase consisting essentially of limits the scope of the claim to the specified materials and those that do not materially affect the basic and novel characteristics of the claimed invention. MPEP 2111.03

The adhesive disclosed in Komeda includes an elastomer and tackifier but also includes plasticizing oil and a wax. (Komeda p. 2, means for resolution, claim 1). Addition of a

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plasticizing oil and wax would affect the physical properties of the resulting adhesive. As amended, independent claims 1, 10, 18, 27, and 36 include an adhesive that consists essentially of an elastomer and a tackifier. Therefore, because Komeda also discloses that a plasticizer and oil are required, Komeda does not teach or suggest the elements of the claimed invention.

Wood teaches a tape roll but does not teach specifics regarding the adhesive formulation. Therefore, even with the combination of Wood, not each and every element of the claimed invention is taught or suggested by the references.

Claims 2-9 each add additional features to claim 1. Claims 11-17 each add additional features to claim 10. Claims 19-26 each add additional features to claim 18. Claims 28-35 each add additional features to claim 27. Claims 1, 10, 18, and 27 are patentable for the reasons given above. Thus, claims 2-9, 11-17, 19-26, and 28-35 are likewise patentable.

In summary, the rejection of claims 1-35 under 35 USC § 103(a) has been overcome and should be withdrawn. In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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